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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/309,367 05/11/99 WILSON

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EXAMINER

VANAMAN, F

ART UNIT

PAPER NUMBER

3611

DATE MAILED:

05/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/309,367

Applicant(s)
Wilson

Examiner
Frank Vanaman

Group Art Unit
3611



☒ Responsive to communication(s) filed on Feb 24, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18, 19, and 22-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 18, 19, and 22-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Status of Application

Applicant's amendment, filed Feb 24, 2000 has been entered in the application. Claims 1-17, 20 and 21 are canceled, claims 18, 19 and 22-38 are pending, claims 37 and 38 having been added.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18, 23-28, 31, 33, 37 and 38 are provisionally rejected under the judicially created doctrine of double patenting over the claims of copending Application No. 09/206,720. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A method of making a board having one or more hollow sections including extruding the board from an aluminum material of either 6000 series or other type ('720 specification, page 4), bending to a predetermined angle and/or shaping the board, followed by heat treating the board to harden it. Note in particular claims 10, 25, 26, 27 of the copending application, and pages 3, 4 and 5 of the specification.

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Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Objections

3. Claim 22 is objected to because of the following informality: the claim appears to contain a deletion within a deletion (note lines 3-4 and 4). For the purpose of this office action, all material within brackets on lines 3 and 4 (i.e., everything except "sections" on line 3 and the period on line 4) is understood to have been deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett (US 3,561,783, cited previously) in view of Mayr (US 5,249,819, cited previously) and Dickert (US 3,722,900). Ellett teaches a ski bike having a ski (30) which may optionally be extruded from aluminum (col. 2, lines 1-2) with top, bottom, left and right sides, in addition to front and rear portions which are later suitably shaped at predetermined angles. The reference of Ellett fails to teach a longitudinally elongated hollow section in the ski.

Mayr teaches a sport ski which may be formed through an extrusion process (col. 3, lines 4-9) having a plurality of hollow longitudinally elongated sections (note figures 2a, 2b, 2c) and which may have a width greater than a height (note figures 2a, 2c). It would have been obvious to one of ordinary skill in the art at the time of the invention to make the extruded ski of Ellett with at least a single hollow section as taught by Mayr for the purpose of reducing weight and increasing resistance to torsion.

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The reference of Ellett as modified by Mayr fails to explicitly teach a method of forming the ski, however such a ski would be formable by the method steps as claimed.

The references of Ellett and Mayr fail to teach the resultant sport ski as being suitable for use as a skateboard. Dickert teaches a wheeled attachment (2, 3, 4, ... 14) for use with skis (1) allowing the use of the skis as skateboard devices, as broadly claimed, for use out of skiing season. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the use of the skis taught by Ellett and modified by Mayr as skateboard devices, as broadly claimed, so that a user can employ the skis for skating use even in a snow-less season.

6. Claims 19, 23, 25-33, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett in view of Mayr, Dickert and Evancho et al. (cited previously). The references of Ellett, Mayr and Dickert are discussed above and fail to teach further steps to include an annealing step to a particular hardness prior to shaping the board and a hardening step after shaping the board.

Evancho et al. teach a process for making plate-shaped aluminum vehicle elements, to include an extrusion step (col. 9, lines 66 - col. 10, line 4), followed by a heat annealing step (col. 10, lines 8-13, 20-25, and 40-42) to a condition less than T-5 hardness (in this case T-4); a working and shaping step (col. 11, lines 60-63) and a hardening step to at least a T-5 condition (in this case T-6; col. 12, lines 9-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the ski element taught by Ellett as modified by Mayr by the steps taught by Evancho et al., the pre-shaping annealing for the purpose of insuring the shaping process does not result in a brittle failure, and the further hardening for the purpose of insuring high strength in the final product.

As regards claims 26, 27, 30 and 31, while Evancho et al. fail to explicitly teach that the extrusion, annealing and hardening steps may be used with a 6000 series alloy, for example 6005 or 6061, it would have been obvious to one of ordinary skill in the art at the time of the invention

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to adjust the particular annealing and hardening times and temperatures to accommodate these alloys in order to allow the same advantages (e.g., insuring the shaping process does not result in a brittle failure; and insuring high strength in the final product) to users of 6005 and 6061 alloys.

As regards claim 32, it would have been obvious to one of ordinary skill in the art at the time of the invention to anneal to a T-0 condition, for example should a great deal of shaping or other working processes be envisioned prior to the final hardening.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett in view of Mayr, Dickert and Le Masson et al. (US 5,248,160, cited previously). The reference of Ellett as modified by Mayr and Dickert fails to teach the inner void spaces as containing a filler. Le Masson et al. teach a ski structure having a plurality of filler elements (core 22 - which may be a foam, wood or aluminum material, filler 31- which may be an elastic foam material). It would have been obvious to one of ordinary skill in the art at the time of the invention to fill the void spaces taught in the ~~core~~ board of Ellett as modified by Mayr and Dickert with a filler material such as a foam or wood, as taught by Le Masson et al. for the purpose of reducing or damping vibrations in the board, and improving handling of the board.

8. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayr in view of Dickert and Evancho et al. (cited previously). Mayr teaches a sport ski which may be formed through an extrusion process (col. 3, lines 4-9) having a plurality of hollow longitudinally elongated sections (note figures 2a, 2b, 2c) and which may have a width greater than a height (note figures 2a, 2c). The reference of Mayr fails to teach the sport ski as being suitable for use as a skateboard. Dickert teaches a wheeled attachment (2, 3, 4, ... 14) for use with skis (1) allowing the use of the skis as skateboard devices, as broadly claimed, for use out of skiing season. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow

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the use of the skis taught by Mayr as skateboard devices, as broadly claimed, as taught by Dickert, so that a user can employ the skis for skating use even in a snow-less season.

The references of Mayr and Dickert fail to teach the ski as being formed from aluminum, and further manufacturing steps to include an annealing step to a particular hardness prior to shaping the board and a hardening step after shaping the board.

Evancho et al. teach a process for making plate-shaped aluminum vehicle elements, to include an extrusion step (col. 9, lines 66 - col. 10, line 4), followed by a heat annealing step (col. 10, lines 8-13, 20-25, and 40-42) to a condition less than T-5 hardness (in this case T-4); a working and shaping step (col. 11, lines 60-63) and a hardening step to at least a T-5 condition (in this case T-6; col. 12, lines 9-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the ski of Mayr as modified by Dickert from an aluminum material as taught by Evancho et al. for the purpose of providing the ski in a lightweight, yet sturdy material which would withstand significant usage. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to produce the ski element taught by Mayr and modified by Dickert by the steps taught by Evancho et al., the pre-shaping annealing for the purpose of insuring the shaping process does not result in a brittle failure, and the further hardening for the purpose of insuring high strength in the final product.

Response to Arguments

9. Applicant's arguments concerning the provisional Double Patenting rejection set forth above and in the previous office action are noted. These rejections are provisional only until such time as the copending application issues as a patent. Applicant's intent to file a terminal disclaimer is noted, although no terminal disclaimer has yet been received, therefore the provisional Double Patenting rejections have not been withdrawn.

As regards applicant's arguments directed to the reference of Stevenson, the examiner agrees, and notes that the rejections based upon the Stevenson reference have been withdrawn.

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As regards the provision of the limitations directed to a skateboard, firstly please note the reference of Dickert, now applied, which teaches the use of wheel elements on skis, rendering the skis as suitable for operation as skateboards, as broadly claimed; secondly as regards applicant's comments (pages 6-7 of the amendment) directed to additional limitations associated with skateboards, these particular limitations are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Giorgio (US 5,312,258) and Spencer (US 4,768,793) teach wheeled gliding devices of pertinence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry; informal or draft communications may be faxed to the same number but should be clearly labeled "UNOFFICIAL" or "DRAFT")

FRANK B. VANAMAN
Patent Examiner
Art Unit 3611

May 8, 2000


5/8/00